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SEP 14 2011

OFFICE OF PETITIONS

In re Application of :
Harari et al. :
Application No. 09/143,233 :
Filed: August 28, 1998 : **DECISION**
Attorney Docket No. SNDK.006UST :
For: FLASH EEPROM SYSTEM WITH :
OVERHEAD DATA STORED IN USER :
DATA SECTORS :

The above-identified application has been forwarded to the undersigned for consideration of a petition for patent term extension entitled "Petition Under 37 CFR 1.181 To Request Review of Patent Term Extension Under Former 35 U.S.C. 154(b)" received on January 20, 2011.

The petition is **dismissed**.

Background

Petitioner asserts that the application was filed on August 28, 1998 and the patent to be issued from the above identified application is entitled to a patent term extension as the application was under appellate review for several years. Petitioner asserts that the Notice of Allowance and Issue Fee(s) Due Notice, included a determination that the patent term extension was 0 days, is in error, as the application is entitled patent term extension.

Petitioner asserts that the application was under appellate review since at least November 2, 2006, when Applicant filed a Notice of Appeal. Petitioner asserts that the application was under appeal until the Examiner issued a new Office Action on entirely new grounds on June 23, 2010.

On August 28, 1998, the above identified application was received by the Office.

On November 2, 2006, a Notice of Appeal was received by the Office.

On March 30, 2007, an Appeal Brief was received by the Office.

On April 14, 2009, a Notification of Non-Compliant Appeal Brief was mailed by the Office.

On August 12, 2009, an Appeal Brief was received by the Office.

On June 23, 2010, a Non-Final Office Action was mailed by the Office.

On October 15, 2010, an amendment was received by the Office.

On November 22, 2010, a Notice of Allowance and Issue Fee(s) Due notice, which included a determination that the patent term extension was zero (0) days, was mailed by the Office.

Applicable Statutes and Regulation

35 U.S.C. 154. Contents and term of patent (in effect on June 8, 1995)

(b) TERM EXTENSION.-

(1) INTERFERENCE DELAY OR SECRECY ORDERS.-If the issue of an original patent is delayed due to a proceeding under section 135(a) of this title, or because the application for patent is placed under an order pursuant to section 181 of this title, the term of the patent shall be extended for the period of delay, but in no case more than 5 years.

(2) EXTENSION FOR APPELLATE REVIEW.-If the issue of a patent is delayed due to appellate review by the Board of Patent Appeals and Interferences or by a Federal court and the patent is issued pursuant to a decision in the review reversing an adverse determination of patentability, the term of the patent shall be extended for a period of time but in no case more than 5 years. A patent shall not be eligible for extension under this paragraph if it is subject to a terminal disclaimer due to the issue of another patent claiming subject matter that is not patentably distinct from that under appellate review.

37 CFR 1.701 Extension of patent term due to examination delay under the Uruguay Round Agreements Act (original applications, other than designs, filed on or after June 8, 1995, and before May 29, 2000).

(a) A patent, other than for designs, issued on an application filed on or after June 8, 1995, is entitled to extension of the patent term if the issuance of the patent was delayed due to:

- (1) Interference proceedings under 35 U.S.C. 135(a); and/or
- (2) The application being placed under a secrecy order under 35 U.S.C. 181; and/or
- (3) Appellate review by the Board of Patent Appeals and Interferences or by a Federal court under 35 U.S.C. 141 or 145, if the patent was issued pursuant to a decision in the review reversing an adverse determination of patentability and if the patent is not subject to a terminal disclaimer due to the issuance of another patent claiming subject matter that is not patentably

distinct from that under appellate review. If an application is remanded by a panel of the Board of Patent Appeals and Interferences and the remand is the last action by a panel of the Board of Patent Appeals and Interferences prior to the mailing of a notice of allowance under 35 U.S.C. 151 in the application, the remand shall be considered a decision in the review reversing an adverse determination of patentability as that phrase is used in 35 U.S.C. 154(b)(2) as amended by section 532(a) of the Uruguay Round Agreements Act, Public Law 103-465, 108 Stat. 4809, 4983-85 (1994), and a final decision in favor of the applicant under paragraph (c)(3) of this section. A remand by a panel of the Board of Patent Appeals and Interferences shall not be considered a decision in the review reversing an adverse determination of patentability as provided in this paragraph if there is filed a request for continued examination under 35 U.S.C. 132(b) that was not first preceded by the mailing, after such remand, of at least one of an action under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151.

(b) The term of a patent entitled to extension under paragraph (a) of this section shall be extended for the sum of the periods of delay calculated under paragraphs (c)(1), (c)(2), (c)(3) and (d) of this section, to the extent that these periods are not overlapping, up to a maximum of five years. The extension will run from the expiration date of the patent.

(c)(1) The period of delay under paragraph (a)(1) of this section for an application is the sum of the following periods, to the extent that the periods are not overlapping:

(i) With respect to each interference in which the application was involved, the number of days, if any, in the period beginning on the date the interference was declared or redeclared to involve the application in the interference and ending on the date that the interference was terminated with respect to the application; and

(ii) The number of days, if any, in the period beginning on the date prosecution in the application was suspended by the Patent and Trademark Office due to interference proceedings under 35 U.S.C. 135(a) not involving the application and ending on the date of the termination of the suspension.

(2) The period of delay under paragraph (a)(2) of this section for an application is the sum of the following periods, to the extent that the periods are not overlapping:

(i) The number of days, if any, the application was maintained in a sealed condition under 35 U.S.C. 181;

(ii) The number of days, if any, in the period beginning on the date of mailing of an examiner's answer under § 41.39 of this title in the application under secrecy order and ending on the date the secrecy order and any renewal thereof was removed;

(iii) The number of days, if any, in the period beginning on the date applicant was notified that an interference would be declared but for the secrecy order and ending on the date the secrecy order and any renewal thereof was removed; and

(iv) The number of days, if any, in the period beginning on the date of notification under § 5.3(c) and ending on the date of mailing of the notice of allowance under § 1.311.

(3) The period of delay under paragraph (a)(3) of this section is the sum of the number of days, if any, in the period beginning on the date on which an appeal to the Board of Patent Appeals and Interferences was filed under 35 U.S.C. 134 and ending on the date of a final decision in favor of the applicant by the Board of Patent Appeals and Interferences or by a Federal court in an appeal under 35 U.S.C. 141 or a civil action under 35 U.S.C. 145.

(d) The period of delay set forth in paragraph (c)(3) shall be reduced by:

(1) Any time during the period of appellate review that occurred before three years from the filing of the first national application for patent presented for examination; and

(2) Any time during the period of appellate review, as determined by the Director, during which the applicant for patent did not act with due diligence. In determining the due diligence of an applicant, the Director may examine the facts and circumstances of the applicant's actions during the period of appellate review to determine whether the applicant exhibited that degree of timeliness as may reasonably be expected from, and which is ordinarily exercised by, a person during a period of appellate review.

(e) The provisions of this section apply only to original patents, except for design patents, issued on applications filed on or after June 8, 1995, and before May 29, 2000.

Opinion

35 U.S.C. § 154(b)(as amended by the "Uruguay Round Agreements Act," enacted December 8, 1994, as part of Public Law 103-465) provides for patent term extension for appellate review, interference and secrecy order delays in applications filed on or after June 8, 1995 and before May 29, 2000. 35 U.S.C. § 154(b)(as amended by the "American Inventors Protection Act of 1999," enacted November 29, 1999, as part of Public Law 106-113) provides for patent term adjustment for administrative delays in applications filed on or after May 29, 2000.

The above-identified application was filed on August 28, 1998. Accordingly, the application is entitled to patent term extension based upon the conditions in 35 U.S.C. § 154(b) in effect on June 8, 1995. The current provisions of 35 U.S.C. § 154(b) became effective on May 29, 2000 and do not apply because the current version of 35 U.S.C. § 154(b) only applies to applications filed on or after May 29, 2000. Pursuant to 35 U.S.C. § 154(b) in effect on June 8, 1995, an applicant can receive patent term extension only if there was an appellate review, interference or a secrecy order delay as set forth in the statute. The statute limits the Office's authority to grant patent term extension to only those situations stated in the statute.

In order to implement 35 U.S.C. 154(b) (in effect between June 8, 1995 and May 28, 2000), the Office promulgated 37 CFR 1.701(c)(3), which, consistent with the statute, requires a final decision in favor of the applicant by the Board of Patent Appeals and Interferences or by a Federal Court in an appeal under 35 U.S.C. 145 to be eligible for patent term extension. The application was not issued due to an adverse determination of patentability by the BPAI, was not delayed due to an interference proceeding, nor was it subject to a secrecy order, as a result, this application is not eligible for the extension under 35 U.S.C. 154 in effect on June 8, 1995 and 37 CFR 1.701. The Office has no authority to grant an extension of the term due to administrative delays except as authorized by 35 U.S.C. § 154.

Petitioner argues that an Office Action on entirely new grounds should be considered "a decision in the review reversing an adverse determination of patentability" for patent term extension purposed and that the term of the patent should be extended. For patent term extension, both 35 U.S.C. 154(b)(2) in effect on June 8, 1995 and 37 CFR 1.701(a)(3) where the delay is not related

to a secrecy order or an interference, require a decision by the BPAI reversing an adverse determination of patentability for the patent application to be eligible for patent term extension under 35 U.S.C. § 154. Since, the application was not issued due to an adverse determination of patentability by the BPAI, the application is not entitled to patent term extension under 35 U.S.C. 154 and 37 CFR 1.701.

The Office regrets the delays in issuing Applicants patent. The Office has no authority to grant an extension of the term due to administrative delays except as authorized by 35 U.S.C. § 154.

Telephone inquiries with regard to this communication should be directed to Mark O. Polutta at (571) 272-7709.

A handwritten signature in black ink, appearing to read 'M. O. Polutta', is positioned above the printed name.

Mark Polutta
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy